



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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In re Application of :  
Volker Schreiner et al :  
Serial No.: 09/701,710 : PETITION DECISION  
Filed: December 1, 2000 :  
Attorney Docket No.: Beiersdorf 688-VMM :

This is in response to applicants' petition under 37 CFR 1.181, filed November 21, 2002, requesting withdrawal of Finality of the last Office action.

A review of the file history shows that this application was accepted under 35 U.S.C. 371 on December 1, 2000, and was accompanied by a preliminary amendment canceling all of the original claims, claims 1-4, and adding claims 5-26. In a first Office action, mailed December 20, 2001, the examiner rejected all of the claims under 35 U.S.C. 112, first paragraph, as containing subject matter not enabled in the specification and claim 26 as being directed to subject matter not described in the specification. Claims 5-12 were rejected under 35 U.S.C. 112, second paragraph, for indefiniteness. Claims 5-20 and 24-26 were rejected under 35 U.S.C. 102(b) as anticipated by the Abstract of BR 9303217. Claims 5-26 were rejected under 35 U.S.C. 102(b) as anticipated by US 5,523,090. Claims 13-26 were rejected under 35 U.S.C. 102(b) as anticipated by WO 96/26705. Claims 5-26 were also rejected under 35 U.S.C. 103(a) as unpatentable over BR 9303217 combined with US 5,523,090.

Applicants replied on March 18, 2002, canceling claims 13-25 and amending claims 5-12. Each of the rejections of record was addressed in the arguments. The submission for unknown reasons lacked one page which was supplied upon request in July, 2002.

The examiner mailed a Final Office action to applicants on October 9, 2002, in which only claim 26 was rejected under 35 U.S.C. 112, first and second paragraphs for lack of description in the specification and for depending on a canceled claim. Claims 5-12 were rejected under 35 U.S.C. 103(a) as unpatentable over PI 9303217. The action was made final based on applicants' amendment necessitating the new rejections.

## DISCUSSION

Applicants argue that the Office action is prematurely Final since a new rejection was set forth not necessitated by applicants' amendments. Applicants argue that the rejection set forth in the second Office action is based on a new reference not previously utilized by the examiner and also that the claims, as presently constituted are narrower than before by incorporation of the limitation of claim 22 into claim 5 and that such should not have raised any new issues before the examiner.


A review of the rejections made in the two Office actions shows that the rejection of claim 26 only under 35 U.S.C. 112, first and second paragraphs, was maintained for the reasons of record. All of the original rejections under 35 U.S.C. 102(b) were withdrawn. The rejection under 35 U.S.C. 103(a) over the combined BR 9303217 and US 5,523,090 references was replaced by a rejection over PI 9303217 alone. The examiner states that BR 9303217 and PI 9303217 are the same reference. This is not technically correct. The BR citation is an English language abstract only while the PI document is a full text English language translation of the document on which the BR abstract is based. It is also noted that the BR abstract was not used alone, but in combination with another reference thus showing it to be deficient in one or more areas. The PI full text translation document is used without reliance on any other document. Thus the rejection under 35 U.S.C. 103(a) set forth in the Final Office action is a new rejection based on a single reference. Since the claims were merely narrowed by incorporation of existing limitations into the base independent claim, the new rejection cannot be considered to be necessitated by applicants' amendments. In consequence of this and in order to allow applicant a full opportunity to respond to the new rejection the Office action should not have been made Final.

## DECISION

Applicants' petition is **GRANTED**. The Finality of the last Office action, mailed October 9, 2002, is withdrawn. The Office action, which appears to be a complete action, is not withdrawn.

**Applicants remain under obligation to reply to the last Office action under 37 CFR 1.111 within the time period set therein or as may be extended under 37 CFR 1.136(a).**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230..

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